

REMARKS

In the Office Action, the Examiner rejected claims 1-3, 6, 7, 12, 36, 38, and 41-43, and withdrew claims 4, 5, 8-11, 13-26, 37, 39, and 40 from consideration. Claims 1-3, 6, 7, 12, 36, 38, and 41-43 remain pending in the present application and are believed to be in condition for allowance. In view of the Rule 132 declaration and the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-3, 6, 7, 12, and 41-43 under 35 U.S.C. § 103(a) as being unpatentable over the Alves publication in view of Hawthorne, U.S. Patent No. 5,066,479 (hereinafter "Hawthorne"); and rejected claims 36 and 38 under 35 U.S.C. § 103(a) as being unpatentable over the Alves publication in view of Merkle et al., U.S. Patent No. 5,569,769 (hereinafter "Merkle").

Removal of the Alves Publication

Section 715.01 (c) of the Manual of Patent Examining Procedure, states the following:

"715.01(c) Reference Is Publication of Applicant's Own Invention [R-2]"

Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself or on his/her behalf...

I. < CO-AUTHORSHIP

Where the applicant is one of the co-authors of a publication cited against his or her application, he or she may overcome the rejection by ... filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

II. < DERIVATION

When the unclaimed subject matter of a patent, application publication, or other publication is applicant's own invention, a rejection>, which is not a statutory bar,< on that patent or publication may be removed by submission of evidence establishing the fact that the patentee, applicant of the published application, or author derived his or her knowledge of the relevant subject matter from applicant. Moreover applicant must further show that he or she made the invention upon which the relevant disclosure in the patent, application publication, or other publication is based. *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969); *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969)."

The Alves publication was first published as an advance article on the internet on November 8, 2002. The present application, U.S. Serial No. 10/551,292 (hereinafter "the '292 application"), claims priority to European Patent no. 03076106.8, filed on April 15, 2003. Accordingly, as this application was filed less than one year after the publication date of the Alves publication, the Alves publication is only available as a reference under 35 U.S.C. § 102(a).

As shown in the Rule 132 declaration, Isabel Rego Santos, João Domingos Galamba Correia, António Manuel Rocha Paulo, and Susana Alves (hereinafter "the Declarants") declare that they are co-inventors on the above-referenced application (i.e., U.S. Application No. 11/551,292) and also co-authors on the Alves reference. The Declarants also declare that they have read pages 3-7 of the Office Action and the portions of the Alves publication cited by the Examiner. The Declarants further declare that they personally conceived or invented any material cited on pages 3-7 of the Office Action, as disclosed in the Alves publication, and that may also be disclosed and claimed in the above-referenced application, U.S. Application No. 10/551,292. The Declarants also declare that their co-author, Angela Domingos, was working under their direction pertaining to any material cited on pages 3-7 of the Office Action, as disclosed in the Alves publication, and that may also be disclosed and claimed in the above-referenced application, U.S. Application No. 10/551,292.

For at least these reasons, the Applicants stress that the material cited on pages 3-7 of the Office Action, as disclosed in the Alves publication, was derived from the inventors of the above-referenced application. As a result, in accordance with M.P.E.P. § 715.01(c), the Alves publication is not "by another" and, thus, is not available as prior art under 35 U.S.C. § 102(a). Accordingly, the Applicants respectfully request that the Alves publication be removed from consideration.

After removal of the Alves publication, the Applicants respectfully assert that both of the Examiner's rejections under 35 U.S.C. § 103, which rely on the Alves publication, are moot. Therefore, the Applicants respectfully request that the rejections be withdrawn and the '292 application be allowed to issue.

Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge any fee deficiency in connection with this Amendment A to Deposit Account Number 13-1160.

Respectfully submitted,



Anthony R. Kinney, Reg. No. 44,834
Mallinckrodt Inc.
675 McDonnell Boulevard
Hazelwood, Missouri 63042
Telephone: (314) 654-8346
Fax: (314) 654-3156

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